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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,305	12/23/2003	Toshihiko Ina	64903-023	5559

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Washington, DC 20005-3096

EXAMINER

BEAUCHAINE, MARK J

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,305	<b>Applicant(s)</b> INA ET AL.	
	<b>Examiner</b> Mark J. Beauchaine	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Patent Application Publication Number US 2004/0153408 A1 by Jones et al ("Jones"). The banknote handling device disclosed by Jones comprises money-in module 14 that receives banknotes from a customer and a counterfeit collection box (see paragraph 0113, lines 7-11) that stores counterfeit banknotes and discrimination module 19 that causes counterfeit banknotes to be stored in said counterfeit collection box and prohibits said counterfeit banknotes from being returned to the customer (see paragraph 0113, lines 7-9). Multiple collection/storage boxes, including genuine banknote storage boxes, are stored in a safe (see Figure 2). Jones further discloses a notification module that notifies the customer of predetermined kind of information indicative of a total amount of money received from the customer (see paragraph 0094, lines 1-12) and an amount of money settled as a transaction, regardless of the result of the counterfeit detection by said discrimination module (see paragraph 0115, lines 1-6 and paragraph 0118, lines 5-17). The notification module information includes a number of each type of the banknotes received by the customer (see paragraph 0094, lines 5-10). Jones

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further discloses output module 136 that outputs a form describing the information (see paragraph 0094, lines 9-11), a setting module that specifies at least one of said multiple storage boxes to said counterfeit collection box (see paragraph 0106, lines 10-14, and paragraph 0108, lines 1-6) and database 33 that stores banknote type information corresponding to a number allocated to each of said multiple storage boxes. Still further Jones discloses temporary storage box (see paragraph 0118, lines 1-4) that temporarily keeps the banknotes received through said money-in module.

Claims 15 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Patent Number US 6,983,880 B2 by Graef et al ("Graef"). The banknote handling device disclosed by Graef comprises money-in module 40 that receives banknotes from a customer, safe 48 that stores banknotes, discrimination module 88 that carries out counterfeit detection and determines each note as counterfeit or as genuine (see column 11, lines 58-62).

Graef further discloses collection box 100 that stores each banknote determined as counterfeit by said discrimination module 88 to be not returned to the customer (see column 12, lines 39-46), and management module 64 that manages customer information for identifying each customer who handles a transaction (see column 23, lines 14-32). The management module maps each banknote involved in the transaction to the customer information and the customer information is mapped to presence or absence of any counterfeit banknote involved in the transaction. The collection box 100 is located outside of safe 48.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Patent Application Publication Number US 2004/0003980 A1 by Hallowell et al ("Hallowell"). The banknote handling device disclosed by Graef comprises money-in module 40 that receives banknotes from a customer, safe 48 that stores banknotes, multiple banknote storage boxes 146 that are located in said safe and store banknotes classified by a banknote type, discrimination module 88 that carries out counterfeit detection and determines each note as counterfeit or as genuine (see column 11, lines 58-62).

Graef further discloses collection box 100 that stores each banknote determined as counterfeit by said discrimination module 88 to be not returned to the customer (see column 12, lines 39-46), and management module 64 that manages customer information for identifying each customer who handles a transaction (see column 23, lines 14-32). The management module maps each banknote involved in the transaction to the customer information and the customer information is mapped to presence or absence of any counterfeit banknote involved in the transaction.

Graef fails to disclose a setting storage module. Hallowell teaches a banknote handling device comprising setting storage module 120 that sets at least one of multiple banknote storage boxes 118a-118f (see Figure 1b) to a collection box which stores each banknote determined as counterfeit by said discrimination module (see paragraph 0081) for the purpose of allowing operation of the apparatus despite one of more storage boxes being previously designated for storage of a particular denomination. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the setting storage module of Hallowell into the apparatus of Graef for the purpose of allowing operation of the apparatus despite one of more storage boxes being previously designated for storage of a particular denomination.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graef in view of Hallowell as applied to claim 16 above, and further in view of Jones.

Graef/Hallowell fails to disclose the act of collectively storing both genuine and counterfeit banknotes of one transaction. Jones teaches the act of collectively storing both genuine and counterfeit banknotes of one transaction for the purpose of isolating banknotes associated with a particular customer who deposited is determined to have deposited counterfeit banknotes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the banknote storage configuration of Jones in the apparatus of Graef/Hallowell for the purpose of isolating banknotes associated with a particular customer who deposited is determined to have deposited counterfeit banknotes.

***Response to Arguments***

Applicant's arguments with respect to claims 1-17, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Claims 1-17, 19 and 20 stand rejected. Claim 18 has been canceled by the Applicant. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark J. Beauchaine whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mjb



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